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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,219	12/12/2001	Hiroharu Matsuoka	MATSUOKA=18	7465
1444	7590	06/20/2005	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			ROBINSON, BINTA M	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/890,219	MATSUOKA ET AL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Binta M. Robinson	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10, 13-25, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1, 2, 13-25 and 29 is/are rejected.
- 7) Claim(s) 3-10, 22 and 30 is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____.                                    |

**Detailed Action**

The obvious double patenting rejection of claims 1-25, 28-29 over US patent 6586630 and the 112, second rejections of claims 24, 25, and 30 made in the office action mailed September 13, 2004 are withdrawn in light of applicant's amendments. Attorney Kornbau agreed to delete "an optionally substituted heterocyclic ring" from the definition of R11 in the claims. However, the claims are not allowable as art was found as indicated below.

**(new objections)**

In claim 1, line 7, page 2 the phrase "phenyl" and in claims 24, 25, is unclear because it is redundant when Cy is equal to formula 2 and R1-R5 are hydrogen.

In claim 30, lines 9-10, the phrase "optionally substituted heterocyclic ring" is unclear and it's redundant because when R14 and R15 form an optionally substituted 3-7 cyclic amine, they are already forming an optionally substituted heterocyclic ring.

**(new rejections)**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) s, 1,2, 13, 14, 15, 16, 17, 18, 19, 20, 21, 23, 24, 25, 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Kotake et. al. (See Reference N).

Kotake et. al., discloses for example, the instant compounds, 107, 108, and 109. At page 38, see the instant compounds.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2, 13, 14, 15, 16, 17, 18, 19, 20, 21, 23, 24, 25, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable Kotake. (See Reference A, English language equivalent to Reference N).

Kotake et. al. teaches the instant compound as shown in Formula 1 wherein A is an amino acid residue provided that A binds with -NR<sub>2</sub>- to form an amide; R<sub>1</sub> is an optionally substituted straight chained or branched alkyl group having 2-7 carbon atoms, R<sub>2</sub> is an optionally substituted straight chained or branched alkyl group having 1-3 carbon atoms; R<sub>3</sub> is -CO-R<sub>7</sub>, an optionally substituted straight chained or branched alkyl group having 1-4 carbon atoms, R<sub>4</sub> is a straight chained or branched alkyl group having 1-6 carbon atoms, a straight chained or branched alkenyl group having 2-6 carbon atoms, a straight-chained or branched alkynyl group having 2-6 carbon atoms, or the formula 2 which is C(R<sub>16</sub>)R<sub>15</sub>R(R<sub>17</sub>), R<sub>7</sub> is a -N(R<sub>12</sub>)R<sub>13</sub> or -OR<sub>14</sub>, R<sub>12</sub> and R<sub>13</sub> which may be the same or different each represent a hydrogen atom, R<sub>14</sub> is a hydrogen atom, a straight-chained or branched alkyl group having 1-6 carbon atoms, or

a cycloalkyl group having 3-7 carbon atoms; R15 is a hydrogen atom or methyl group; R16 and R17 are taken together and represent a cycloalkyl or cycloalkenyl group having 3-7 carbon atoms. At columns 90-91, see the compound of formula I. The difference between the prior art compound and the instantly claimed compounds is the teaching of a subgenus of compounds versus a genus of compounds. It would have been obvious to one of ordinary skill in the art to select various known radicals within a genus to prepare structurally similar compounds. For instance, see the compound, 108 at column 36, where a disclosed species is exemplified. Accordingly, the compounds are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compounds over those of the generic prior art compounds.

Claims 3-10, 22, and 30 are objected to because they are based on a rejected claim.  
The IDS filed 7/27/01 and 7/18/2002 have been considered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (571) 272-0692. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703)308-4242, (703)305-3592, and (703)305-3014.

Art Unit: 1625

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)-272-1600.

BMR  
May 27, 2005



Cecilia J. Tsang  
Supervisory Patent Examiner  
Technology Center 1600